

Remarks

In the Official Action mailed December 24, 2007, the presently claimed embodiments of the invention were rejected as being unpatentable under 35 U.S.C. §§ 102, 103. Each of these rejections is addressed in turn below.

5

35 U.S.C. § 102 Rejections

Claims 1-8, 11-14, 17, and 18 were rejected under 35 U.S.C. § 102(e) as being anticipated by
10 Sheddan (US 2002/0194088) (“Sheddan”).

Arguments

It is noted that the Examiner rejected Applicant’s Claim 1, specifically Claim 1(d), as being
15 anticipated by Sheddan, ¶¶ 28-30. Sheddan does not anticipate Claim 1(d). Claim 1(d) includes the step of “allowing the user to select a medium for display and storage of the compilation of discount purchase offers.” More particularly, Applicant’s specification discusses that the options available for medium selection range from plastic cards, multi-fold cards, coupon books, electronic coupon books, and other media. *See* Application, at Pg. 11, Lns. 16-19; *see also* Pg.
20 12, Lns. 1-5; Pg. 13, Lns. 15-25. Sheddan, ¶¶ 28-30 do not teach allowing the user to select from among such media. Sheddan specifically limits the medium to printed coupon books. *See* Sheddan, ¶ 30. Sheddan does not allow for selection of any different media. Rather, Sheddan allows for selection of cover *graphics, design, and color*. *See* Sheddan, ¶ 29.

The Examiner also rejected Applicant's Claim 2, which is dependant on Claim 1, as being anticipated by Sheddan, ¶ 28. Because Claim 1(d) is not anticipated by Sheddan, as set forth above, Sheddan does not anticipate Claim 2.

5

The Examiner rejected Applicant's Claim 3, which is dependant on Claim 1, as being anticipated by Sheddan, ¶ 24. Because Claim 1(d) is not anticipated by Sheddan, as set forth above,

Shedden does not anticipate Claim 3. Moreover, the school referenced in Sheddan, ¶ 24 is not synonymous with a marketing subcontractor in Claim 3. More specifically, as the amended

10 Claim 3 clarifies, the marketing subcontractor referenced therein assists in compiling and assimilating merchant offers *into* the database, *see* Application, at Pg. 7, Lns. 12-23; Fig. 1, but the *customization* of the offers for ultimate compilation is done by a user, as referenced in Claim 1 of the Application. Therefore, a user, not a marketing subcontractor, is synonymous with a school as referenced in Sheddan, ¶ 24. Sheddan does not teach such a role in the method by a
15 marketing subcontractor.

The Examiner rejected Applicant's Claim 4, which is dependant on Claim 1, as being anticipated by Sheddan, ¶ 24. Because Claim 1(d) is not anticipated by Sheddan, as set forth above,

Shedden does not anticipate Claim 4. Moreover, the restaurant referenced in Sheddan, ¶ 24 is

20 not synonymous with a coupon card distribution company in Claim 4. More specifically, as the amended Claim 4 clarifies, the coupon card distribution company referenced therein assists in compiling and assimilating merchant offers *into* the database, *see* Application, at Pg. 7, Lns. 12-23; Fig. 1, but the *customization* of the offers for ultimate compilation is done by a user, as

referenced in Claim 1 of the Application. Sheddan does not teach such a role in the method by a coupon card distribution company. Furthermore, as a general matter, a restaurant cannot be synonymous with a coupon card distribution company, which is a unique entity organized to process, customize, and distribute the presentation of offers. *See* Application, at Pg. 7, Lns. 13-

5 15.

The Examiner rejected Applicant's Claim 5, which is dependant on Claim 1, as being anticipated by Sheddan, ¶ 24. Because Claim 1(d) is not anticipated by Sheddan, as set forth above,

Sheddan does not anticipate Claim 5. Moreover, unlike Applicant's Claim 1, Sheddan does not teach that a user is a local or national merchant, as the term "user" is defined by Applicant. As

10 "user" is defined by Applicant, a user is one who may be provided with a customized compilation of discount purchase offers. *See* Application, Claim 1; *see also* Application, Pg. 10, Lns. 27-29 ("this group includes, but is not limited to: consumers 22, licensees/franchisees 24, national or local fundraising organizations 26, *and national or local merchants* 28"). However, Sheddan, ¶ 24 only teaches the provision of a customized compilation to *non-merchants*.

15 Sheddan defines merchant only as one who offers a coupon, not one who may be provided with a customized compilation of discount purchase offers. *See id.*

The Examiner rejected Applicant's Claim 6, which is dependant on Claim 1, as being anticipated by Sheddan, ¶ 33. Because Claim 1(d) is not anticipated by Sheddan, as set forth above,

20 Sheddan does not anticipate Claim 6. Moreover, Sheddan, ¶ 33 does not mention "register user."

Furthermore, "register user" is not synonymous with a licensee.

The Examiner rejected Applicant's Claim 7, which is dependant on Claim 1, as being anticipated by Sheddan, ¶ 33. Because Claim 1(d) is not anticipated by Sheddan, as set forth above, Sheddan does not anticipate Claim 7. Moreover, unlike Applicant's Claim 1, Sheddan does not teach that a user is a franchisee, as the term "user" is defined by Applicant. As "user" is defined by Applicant, a user is one who may be provided with a customized compilation of discount purchase offers. See Application, Claim 1; see also Application, Pg. 10, Lns. 27-29 ("this group includes, but is not limited to: consumers 22, licensees/franchisees 24, national or local fundraising organizations 26, and national or local merchants 28"). However, Sheddan, ¶ 33 defines an "organization (merchant)" only as one who offers a coupon, not one who may be provided with a customized compilation of discount purchase offers.

The Examiner rejected Applicant's Claim 8, which is dependant on Claim 1, as being anticipated by Sheddan, ¶ 7. Because Claim 1(d) is not anticipated by Sheddan, as set forth above, Shedden does not anticipate Claim 8. Moreover, Sheddan, ¶ 7 does not teach that a local or national fundraising organization is a user. Rather Sheddan, ¶ 7 merely mentions that schools may sell coupon books for fundraising. Sheddan, ¶ 8 discusses only that these organizations ultimately benefit from lower production costs, but the Applicant respectfully submits that organizations need not themselves be users to so benefit.

The Examiner rejected Applicant's Claim 11, which is dependant on Claim 1, as being anticipated by Sheddan, ¶ 26. Because Claim 1(d) is not anticipated by Sheddan, as set forth above, Sheddan does not anticipate Claim 11.

The Examiner rejected Applicant's Claim 12, which is dependant on Claim 1, as being anticipated by Sheddan, ¶ 30. Because Claim 1(d) is not anticipated by Sheddan, as set forth above, Sheddan does not anticipate Claim 12.

5 The Examiner rejected Applicant's Claim 13, which is dependant on Claim 1, as being anticipated by Sheddan, ¶¶ 33, 25, 37, 28-30, 31, 29, 26, 24, 27, 28, and 9. Because Claim 13(c), (e), (f), (h), (j), (k), and (l) are not anticipated by Sheddan, as set forth below, Sheddan does not anticipate Claim 13. Sheddan, ¶¶ 28-30 do not anticipate Claim 13(c). Claim 13(c) includes the step of "prompting the user to select a card medium." More particularly, Applicant's
10 specification discusses that the options available for medium selection range from plastic cards, multi-fold cards, coupon books, electronic coupon books, and other media. *See* Application, at Pg. 11, Lns. 16-19; *see also* Pg. 12, Lns. 1-5; Pg. 13, Lns. 15-25. Sheddan does not teach prompting the user to select from among such media. Sheddan specifically limits the medium to printed coupon books. *See* Sheddan, ¶ 30. Sheddan does not allow for selection of any different
15 media. Rather, Sheddan allows only for selection of cover *graphics, design, and color*. *See* Sheddan, ¶ 29. Moreover, while Shedden, ¶¶ 28-30 mentions that a user may select cover graphics, design, and color, the user is not prompted to do so.

Also, Sheddan, ¶ 28 does not anticipate Claim 13(e). Claim 13(e) includes the step of
20 "prompting the user to select one or more discount purchase offers." While Shedden, ¶ 28 mentions that a user selects or may select purchase offers, the user is not prompted to do so.

Moreover, Sheddan, ¶ 28 does not anticipate Claim 13(f). Claim 13(f) includes the step of “displaying pricing information corresponding to the discount purchase offers selected.” While Sheddan, ¶ 28 mentions displaying coupons, it does not teach displaying the pricing information corresponding to those coupons as does Claim 13(f).

5

Furthermore, Sheddan, ¶ 29 does not anticipate Claim 13(h). Claim 13(h) includes the step of “displaying a preview of the offers and card design selected.” Sheddan, ¶ 29 does not mention or imply the display of a preview of the offers and card design selected as does Claim 13(h).

10 Also, Sheddan, ¶¶ 24, 30 do not anticipate Claim 13(k). Claim 13(k) includes the step of “prompting a user to select a form of payment.” While Shedden, ¶ 30 mentions entering ordering information, neither it nor ¶ 24 teach prompting a user to select a form of payment as does Claim 13(k).

15 Finally, Sheddan, ¶¶ 26, 30 do not anticipate Claim 13(l). Claim 13(l) includes the step of “displaying a confirmation of payment received.” While Sheddan, ¶ 30 mentions that an order is verified and confirmed, neither it nor ¶ 26 teach displaying a confirmation of receipt of payment as does Claim 13(l).

20 The Examiner also rejected Applicant’s Claim 14, which is dependant on Claim 13, as being anticipated by Sheddan, ¶ 28. Because Claim 13(c), (e), (f), (h), (j), (k), and (l) are not anticipated by Sheddan, as set forth above, Sheddan does not anticipate Claim 14. Moreover,

Sheddán, ¶ 28 does not teach categorization by alphabetization in a format selected by the user as does Claim 14.

The Examiner rejected Applicant's Claims 17-18, which are dependant on Claim 13, as being
5 anticipated by Sheddán, ¶¶ 9, 30. Because Claim 13(c), (e), (f), (h), (j), (k), and (l) are not anticipated by Sheddán, as set forth above, Sheddán does not anticipate Claims 17-18.

It is believed that the rejections based on 35 U.S.C. § 102(e) have all been addressed.

10 ***35 U.S.C. § 103 Rejections***

Claims 9, 10, 15, and 16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Sheddán (US 2002/0194088) ("Sheddán"), in view of Long (US 6,572,149) ("Long").

15 ***Arguments***

It is noted that the Examiner rejected Claims 9 and 10, which are dependant on Claim 1, as being obvious over Sheddán in view of Long. However, as set forth above, Sheddán does not anticipate Claim 1(d), and therefore, combining Sheddán and Long does not teach of all of
20 Applicant's claim limitations.

It is further noted that the Examiner rejected Claims 15 and 16, which are dependant on Claim 13, as being obvious over Sheddán in view of Long. However, as set forth above, Sheddán does

not anticipate Claim 13(c), (e), (f), (h), (j), (k), and (l), and therefore, combining Sheddan and Long does not teach of all of Applicant's claim limitations.

It is believed that the rejections based on 35 U.S.C. § 103(a) have all been addressed.

5

Conclusion

It is believed that all issues raised by the Examiner have been addressed in the present response. In light of the foregoing, it is respectfully requested that the rejections of Claims 1-18 be withdrawn and a Notice of Allowance be issued. If the Examiner wishes to discuss any of the issues raised in this response, Applicant him to contact the undersigned by telephone.

DATED this 30th day of April, 2008.

Respectfully submitted,



Brent T. Winder
Attorney for Applicant
Registration No. 46,250
JONES, WALDO, HOLBROOK & McDONOUGH
170 South Main Street, Suite 1500
Salt Lake City, Utah 84101-1644
Telephone: (801) 521-3200
Facsimile: (801) 328-0537